

Appl. No. 09/749,609  
Response Dated October 13, 2004  
Reply to Office Action of August 14, 2003

**REMARKS**

Claims 1 and 7 have been amended. Claims 1-10 stand in this application.  
Favorable reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-4, 7-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schofield (U.S. Patent No. 5,860,072). Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Schofield reference fails to disclose each and every element recited in claims 1 and 7. For example, with respect to claim 1, the Schofield reference fails to disclose a method comprising at least:

identifying an ordering of said attribute specifications;  
[and]  
updating said attribute specifications according to said identified order....

Therefore, Applicant submits that the Schofield reference fails to anticipate claim 1. Accordingly, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claim 1 and claims 2-6, which depend therefrom.

Furthermore, with respect to claim 7, the Schofield reference fails to disclose a medium having information recorded thereon to cause a computer to:

identify an optimized ordering of said attribute specifications; [and]  
update said attribute specifications according to said identified order....

Therefore, Applicant submits that the Schofield reference fails to anticipate claim 7. Accordingly, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claim 7 and claims 8-10, which depend therefrom.

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Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schofield in view of Welling et al. (Welling and Ott, *Customizing IDL Mappings and ORB Protocols*, April 2000, Springer-Verlag Berlin Heidelberg IFIP/ACM International Conference on Distributed Systems Platforms). Further, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schofield in view of Juric et al. (Juric, Rozman, and Nash, *Java 2 Distributed Object Middleware Performance Analysis and Optimization*, Aug. 2000, V.35(8), ACM SIGPLAN Notices). Applicant respectfully traverses these rejections.

Claims 5 and 6 depend from independent claim 1. As previously discussed, Schofield fails to disclose all the features of claim 1. Welling and Juric also fail to disclose the missing features of claim 1. Consequently, claims 5 and 6 represent patentable subject matter for at least the same reasons given for claim 1. Accordingly, removal of the obviousness rejections for claims 5 and 6 is respectfully requested.

With respect to claims 5 and 6, Applicant respectfully submits that the Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

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prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

For at least the above reasons, Applicant submits that claims 1-10 recite novel features not shown by the cited references, taken alone or in combination, and therefore, even when combined the references fail to teach or suggest all the elements recited in claims 1-10. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-10 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

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The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



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John F. Kacvinsky, Reg. No. 40,040  
Under 37 CFR 1.34(a)

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Deborah C. Higham — 10-13-04  
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Dated: October 13, 2004

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